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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,380	02/02/2004	Milind Rajopadhye	DM-6999(BMS-2594)	9680

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EXAMINER
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BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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06/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/770,380

Applicant(s)

RAJOPADHYE ET AL.

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 58-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 58-61 is/are rejected.
- 7) ☒ Claim(s) 62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, which included addition of new claims 58-62 and amendment to claim 1, filed on 3/7/2007 has been entered. Claims 1 and 58-62 are now pending. In view of applicants' amendment, the following applies.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 58-61 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compound of claim 62 comprising a specific metallopharmaceutical with the recited functional language does not reasonably provide enablement for any or all metallopharmaceutical with varying metals, chelators, indazole nonpeptide with a functional language which include upregulation of angiogenesis generically embraced in the claim language. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the invention commensurate in scope with these claims. for reasons of record. To repeat: The following apply.

The instant compound claims 1 and 58-61 are drawn to " comprising: a targeting moiety and a chelator wherein the targeting moiety is bound to the chelator is an indazole nonpeptide wherein the targeting moiety binds to a receptor that is upregulated during angiogenesis. The scope of the claims includes any or all chelators, any or all indazoles of formula Ia and Ib with any or all receptor antagonism that relates to upregulation of angiogenesis including those yet to be discovered as due said mode of action for which there is no enabling disclosure. As recited, the scope of these claims includes large number metals, unknown number of chelators, millions and millions of indazole compounds and unknown of receptors for upregulation of angiogenesis. For lack of precise enabling disclosure, one trained in the art has to identify and make first millions and millions of indazoles as embraced in formula Ia and Formula Ib and evaluate their interaction with large number of receptors whose numbers are undefined as embraced in the term " a receptor" and thus identify which of these compounds interact which of the unknown list of receptor. Having thus identified, by extensive experimentation, one trained in the art need to attach these compounds to chelator whose number and choices remains undefined with or without a linker group and reevaluate them with unknown list of receptor, select those which interact with a receptor that upregulate angiogenesis, make all sort of chelated compounds and reevaluate their activity toward the receptor to establish that they indeed upregulate angiogenesis and establish that the composition indeed has the said functional property. Having done these extensive

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experimentation, one trained in the art has to redeem such a composition as applicants' composition which is by no means the criteria set forth in 112 first paragraph objective enablement requirement.

. The instant compounds are disclosed to be receptor vitronectin receptor antagonists and it is recited that the instant compounds are therefore useful as antagonists for any or all receptors diseases stated above for which applicants provide no competent evidence. It appears that the applicants are asserting that the embraced compounds because of their mode action vitronectin antagonists that would be useful for all sorts of chemotherapy even when such a receptor is not involved and the compounds are antagonists of other receptors. However, the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases such as psoriasis, lung cancer, brain cancer, pancreatic cancer, colon cancer etc. are very difficult to treat and despite the fact that there are many anticancer drugs.

The scope of the claims involves millions and millions of compounds of claim 1 as well as large number of chelator, and receptors embraced by an indazole nonpeptide, chelator, a receptor etc.

In addition, claim 1 is deemed as reach through claim wherein a mode of action or functional language is recited first and then compounds that relate to the mode of action is claimed. In the instant case because of the mode of action is a receptor

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antagonist with upregulation of angiogenesis inhibitor, the instant compounds are implied to be useful for chemotherapy.

No compound has ever been found to interact with any or all receptors generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "compound" is contrary to our present understanding of receptors and their ligands.

Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Utility and Written Description Guidelines, at 66 FR 1092-1099, 2001 wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the Vitronectin receptor antagonist activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. Prior art search in the related area namely indazole compounds clearly shows that indazoles can have variety of uses with varying degree of interaction with macromolecules and it is not possible predict their action a priory. See for examples US 2005/010,457 which teaches indazole as JNK inhibitors, US 2005/0101614, which teaches indazole useful as GABA antagonist and US 5,928,998 which teaches indazole as herbicides. (Note only few are cited to illustrate the point. Search in East database for indazole, class 548, subclasses

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.361.1, 362. 1, 362.5 & 364.5, show over 600 US Patents, most of these indazoles having interaction with receptors not involved in angiogenesis.).

Note MPEP 2164.08(b) states that claims that read on "... significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative.". Clearly that is the case here.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: " Compound comprising: a chelator, an indazole nonpeptide targeting moiety covalently bound to the chelator, that require receptor antagonist activity that upregulate angiogenesis

2) The state of the prior art: Prior art search in the area of indazole itself showed that activity of the said compound varies and is not limited instant vitronectin antagonistic activity. are unpredictable and are still exploratory. There was no evidence in the prior art that because a compound interact with a specific receptor such as vitronection would lead to interaction with any or all receptors and upregualte angiogenesis as embraced in the instant claims.

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3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for upregulation of angiogenesis of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show a composition comprising any or all metals and any or chelators and any or all indazoles that interact with any or all receptors would lead upregulation angiogenesis and hence the desired use as chemotherapeutic agents and the state of the art as noted does not lend support for such a composition

6) The breadth of the claims: The instant claims embrace millions and millions of compounds, various chelators . The breadth is too large.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general,



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and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was 'filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

### ***Allowable Subject Matter***

Claim 62 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any

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inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

  
Venkataraman Balasubramanian

5/29/2007